

REMARKS

Reconsideration of the above-identified patent application in view of the proposed amendment above and the remarks below is respectfully requested.

Claims 14-23 have been canceled in this paper. Claims 1 and 12 have been amended in this paper. New claims 24-27 have been added in this paper. Therefore, claims 1-3, 5-13 and 24-27 are pending and under active consideration.

Claims 1-3 and 5-13 stand rejected under 35 U.S.C. 103(a) "as being unpatentable over Staheli, USP 5,028,225 in view of Takagi et al., USP 4,875,647 for the reasons cited in the previous office action." In support of the rejection, the Patent Office states the following in the final Office Action of June 4, 2003:

The cited primary reference substantially teaches the basic claimed process of molding a continuous cable tie. The detailed process steps include providing a continuous web or film of material wherein the web passes through an injection mold and a plastic material having a desired feature is molded onto the section of web material. The product is cut into individual units upon hardening of the resin. Note that cable ties is suggested, see col. 1, lines 17-22. Also see col. 3, line 30 to col. 4, line 25.

The added reference is cited to show the conventionality of molding a head configuration as claimed, onto a continuous strip of material in the molding of a cable tie. The detailed features include providing a head having head, a channel and a locking tang. The tail portion can be inserted into the head, through the channel and for a loop. See col. 3, lines 5-65 and claims 1-6.

It would have been obvious to so mold a head of the configuration as shown in the added reference, when performing the continuous molding process set forth in the primary reference, for forming a composite cable tie having the conventional head design as disclosed in the applied prior art.

Note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Later in the same Office Action, the Patent Office states the following:

Applicant argues that the art does not teach forming a continuous strap material, cutting to desired length, and then insert molding.

This is not found persuasive in view of col. 3, lines 35-67, particularly lines 64-67, wherein the dam perforates the web material prior to molding. The perforating step is readable on the claimed cutting and it would have been obvious to cut the web prior to molding for forming individual units as desired.

In the Advisory Action of January 26, 2004, the Patent Office states the following:

Applicant argues the newly added limitation, stating that such overcomes the applied prior art because the prior art does not show the sequence of steps of forming, then cutting, then insert-molding; and further, that the prior art forms a continuous web and molds one article at a time, whereas the instant claims can cut a web into a plurality of straps and permit many molded articles to be formed on a given web simultaneously (see arguments btm pg 8 to top pg 9); the added limitation does not limit the claimed method to the argued sequence of steps because of the open language used (comprising); by using the term "comprising", any reference teaching the claimed steps, although it may include additional steps, meets the claim - the art shows perforation "before liquid material is injected" (see col. 3 of Staheli as referred in the previous office action) and meets the limitation claimed - the argument stating that the dam does not cut an article to its final size is irrelevant; it clearly teaches cutting prior to molding. Note further that the claim does not set forth "cutting to its finished size" but rather to a desired length, and this limitation is met by the applied art. Furthermore, the claim does not recite cutting a web into a plurality of straps, or molding many articles

simultaneously; thus the argument regarding whether the prior art teaches these unclaimed features does not give patentable weight to the claims of record.

Applicant respectfully traverses the foregoing rejection for at least the reasons provided in Applicant's Amendment of December 4, 2003.

With respect to the Patent Office's comments in the Advisory Action that the claims, which use the term "comprising" as a transition term, are not limited to the argued sequence of steps and, therefore, are indistinguishable over the applied art, Applicant respectfully traverses. The instant claims clearly specify that the forming, cutting and insert-molding steps must occur in a particular sequence (note the use of the word "then" in the claims to specify that the cutting step must occur after the forming step and that the insert-molding step must occur after the cutting step). The fact that the claims use "comprising" as a transition term and, therefore, may include other steps, in addition to the recited forming, cutting and insert-molding steps, does not alter the prescribed sequence of forming, cutting and insert-molding steps.

With respect to the Patent Office's comments that the claims do not set forth that the strap is cut "to its finished size" and that, therefore, the applied art meets the limitation of cutting to a desired length, Applicant has amended independent claims 1 (from which claims 2-3 and 5-11 depend) and 12 (from which claim 13 depends) so that they now require that the cutting step involve cutting the strap material to yield an individual strap of finished size.

Accordingly, for at least the above reasons, the foregoing rejection should be withdrawn.

New claim 24, from which claims 25-27 depend, is patentable over the art of record for at least the reasons given above and additionally for the reason that the art does not teach or suggest, among other things, cutting the continuously-molded strap material into a plurality of straps of


finished size and then, simultaneously insert-molding front portions on a plurality of said individual straps.

In conclusion, it is respectfully submitted that the present application is in condition for allowance. Prompt and favorable action is earnestly solicited.

If there are any fees due in connection with the filing of this paper that are not accounted for, the Examiner is authorized to charge the fees to our Deposit Account No. 11-1755. If a fee is required for an extension of time under 37 C.F.R. 1.136 that is not accounted for already, such an extension of time is requested and the fee should also be charged to our Deposit Account.

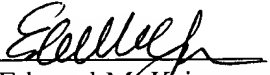
Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 4, 2004.


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